

Remarks**Application Status and Disposition of Claims**

The Action indicates that claims 7-11, 14, and 15 are pending. Of the pending claims, the Examiner considered claim 8, maintaining the restriction requirement with respect to the remainder of the claims. Applicants thank the Examiner for withdrawing the election of species requirement.

With this Amendment, Applicants amend claims 7 and 8, cancel claims 11, 14, and 15, and add new claims 20 and 21. No new matter has been added.

Applicants allow the withdrawn claims to remain pending, as they are subject to possible rejoinder.

Priority

Applicants thank the Examiner for acknowledging Applicants' claim to priority and indication that all required documents have been received by the Patent Office.

Information Disclosure Statements

Applicants thank the Examiner for indicating consideration of all of the documents filed in Information Disclosure Statements on August 15, 2007 and April 23, 2008.

Claim Rejections – 35 U.S.C. § 103

The Office Action rejects claim 8 over Prout et al. (Journal of Organic Chemistry, 1962, 27, p. 1488-1490) when considered with Francke (U.S. Patent No. 4,853,217). Applicants respectfully disagree with the rejection for the reasons that follow.

Applicants note that Prout et al. describes the optical rotation of “[α]²⁴D-36.95°” on page 1489, left column, line 21, and describes on line 22 of the same column that “[t]his bromide was considerably racemized.” Prout et al. further describes in lines 22-26 of the same column that

"(cf. (+)- or (-)-2-bromooctane where the reported specific maxima are $\pm 39^\circ$.¹¹" Footnote 11 is a document by W. Gerrard, J. Chem. Soc., 848 (1945).

In the Gerrard reference (a copy of which is enclosed), results of studies are disclosed, wherein (+)- β -octanol was brominated under various conditions to convert it to (-)-2-bromooctane. Applicants submit that Prout et al. is simply predicting based on Gerrard that the (-)-2-bromoheptane, whose carbon number is less than (-)-2-bromooctane *by one*, will exhibit an optical rotation of about 39° , although the real optical rotation of the (-)-2-bromoheptane was unknown. Consequently, Prout et al. notes from a qualitative standpoint that "*this bromide was considerably racemized.*"

Thus, the real optical purity is not clarified in Prout et al., while Prout et al. clearly states that "*this bromide was considerably racemized.*" Therefore, Applicants respectfully submit that (-)-2-heptylmalonic acid having an optical purity of 90% or higher was not obtained.

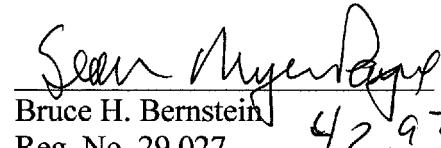
Prout et al. do not teach specific methods for isolating racemic substances. Therefore, based on the disclosure of the cited references, those skilled in the art could not have provided a method wherein the R-isomer or S-isomer having a higher optical purity as described in the present claims is obtained by way of isolating the R-isomer therefrom. Applicants respectfully submit that the present invention is nonobvious over Prout et al.

Applicants further note that Francke does not refer to an optical purity, and does not disclose a method for obtaining an optically active R-isomer or S-isomer. Thus, even if one skilled in the art were to combine Prout et al. with Francke, the skilled person would not expect to achieve the efficiency of the present invention for obtaining (R)- or (S)-1-methylalkyl malonic acid having an optical purity of 90% e.e. or greater.

In view of the foregoing remarks and amendments, Applicants respectfully submit that the claims are nonobvious over the cited art, and respectfully request withdrawal of the rejections.

Should the Examiner have any questions, please contact the undersigned at the telephone number provided below.

Respectfully submitted,
Yasukata DEKISHIMA


Bruce H. Bernstein 4/29/20
Reg. No. 29,027

September 17, 2010
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191